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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,095	06/29/2001	Dwip N. Banerjee	AUS920010447US1	6698

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,095

Applicant(s)

BANERJEE ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-35 are presented for examination on the merits. Applicant's formal drawings filed on 4 September 2001 have been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

By way of example, an omitted step included in applicant's disclosure and corresponding drawings is where seller digitally signs the time of ownership. The applicant must particularly point out and distinctly claim the subject matter the applicant regards as his invention without omitting essential steps/elements or relationships between the elements/steps that determine the scope and describe the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al., U.S. Patent 5,910,987 A1.

As per the following claim, Ginter et al. discloses:

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1. A method of augmenting digital rights management, the method comprising: associating a first field with an electronic document, wherein the first field identifies a current owner of the electronic document (column 144, line 12 – column 145 line 49); and associating a second field with the electronic document, wherein the second field contains information about previous ownership of the electronic document (figures 26a-b and associated text); and wherein access control software allows access to the property only upon verification that a user satisfies specified requirements for access (columns 82-83; column 135, lines 20-34).

2. The method according to claim 1, wherein the access control software restricts use of the electronic property to the person identified as the current owner (column 83, line 63 – column 84, line 67).

3. The method according to claim 1, further comprising notifying the electronic property's manufacturer in case of property rights violations (column 42, lines 4-16; see also section describing certificates).

4. The method according to claim 1, further comprising: if ownership of the electronic document is transferred from the current owner to a subsequent owner: in the first field, replacing the current owner's name with the subsequent owner's name; and in the second field, adding information about the subsequent owner (column 26 and associated figures).

5. The method according to claim 4, further comprising allowing access to the property by the

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subsequent owner only after the current owner has electronically signed an entry identifying the subsequent owner (columns 19, 21-22).

6. The method according to claim 4, further comprising storing the information associated with the ownership transfer in a backup server (columns 17-18).

7. The method according to claim 4, further comprising sending notice of the transfer of ownership to the electronic property's manufacturer (columns 286-289).

8. The method according to claim 4, wherein the subsequent owner inherits the same access privileges as the current owner (column 57, 25-34).

9. The method according to claim 1, further comprising: if use of the electronic document is temporarily loaned by the current owner to a borrower: associating a third field with the electronic document, wherein the third field identifies the current borrower of the electronic document and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (columns 55-59).

10. The method according to claim 9, wherein access control hardware restricts access to the electronic property to the person identified as borrower (columns 55-60).

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11. The method according to claim 9, wherein the current owner cannot access the electronic property during the duration of the loan period (columns 55-60).

12. The method according to claim 9, further comprising storing the information about the loan in a backup server (column 2-8see rights operating system in summary).

13. The method according to claim 9, wherein the current owner may simultaneously loan the electronic property to multiple borrowers (columns 55-61; see access control and rules and controls).

14. The method according to claim 9, further comprising sending notice of the loan to the electronic property's manufacturer (columns 83-84; see certificates as above).

15. The method according to claim 9, wherein the borrower acquires a specified portion of the owner's access privileges (columns 55-61; see access control and rules and controls).

16. The method according to claim 1, wherein the property title is stored in the same file with the digital property itself (figure 17 and associated text).

Claims 17-32 directed to a computer readable medium are rejected as above.

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33. A system for augmenting digital rights management, the method comprising: a first register which associates a first field with an electronic document, wherein the first field identifies a current owner of the electronic document; and a second register which associates a second field with the electronic document, wherein the second field contains information about previous ownership of the electronic document; and wherein access control software allows access to the property only upon verification that a user satisfies specified requirements for access (see claim 1 above; columns 23-49).

34. The system according to claim 33, further comprising: if ownership of the electronic document is transferred from the current owner to a subsequent owner: a first updating component which replaces the current owner's name with the subsequent owner's name in the first field; and a second updating component which adds information about the subsequent owner in the second field (see rejection under first group; columns 23-49).

35. The system according to claim 33, further comprising: if use of the electronic document is temporarily loaned by the current owner to a borrower: a third register which associates a third field with the electronic document, wherein the third field identifies the current borrower of the electronic document and designates the duration of the time period of the loan; and wherein access control software allows borrower access to the property only during the duration of the loan period (see rejection under first group; columns 23-49).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Patent No. 5,745,879 to Wyman.
- Patent No. 5,260,999 to Wyman.

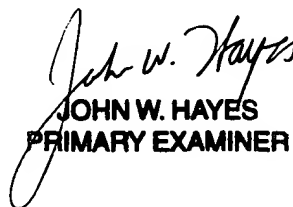
Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
December 13, 2002


JOHN W. HAYES
PRIMARY EXAMINER